

## **REMARKS**

Claims 5 to 11 and 24 to 61 are pending in the application, of which claims 29 to 61 are currently under consideration. Claims 5 to 11 and 24 to 28 are withdrawn from consideration.

### **Priority**

The Examiner alleged that applicant "has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 . . . ." Action at page 2. Specifically, the Examiner alleged that the specification does not contain a specific reference to the prior application. *Id.*

Applicant respectfully traverses. In the Amendment filed November 18, 2002, applicant amended the specification to include specific reference, and the relationship, to U.S. Application No. 08/318,393, filed October 5, 1994 (the '393 application). The claim for benefit of the '393 application was acknowledged by the Examiner in the Office Action mailed February 7, 2003.

Applicant respectfully requests reaffirmation that applicant has complied with the provisions of 35 U.S.C. § 120.

### **Rejection Under 35 U.S.C. § 102(e)**

The Examiner rejected claims 29, 32, 35, 38, 41, 44, 47, and 50 under 35 U.S.C. § 102(e) as allegedly being anticipated by Flanagan et al., U.S. Patent No. 5,795,734 (the '734 patent). Action at page 3. The earliest possible filing date of the '734 patent is

September 19, 1994.<sup>1</sup> The Examiner alleged that the “effective filing date of the instant application is 10/03/95 because Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120.” Action at page 4. The Examiner further alleged that applicant must submit an affidavit under 37 C.F.R. § 1.608(b) in order to overcome the present rejection. *Id.*

As discussed above, applicant has complied with the requirements for claiming benefit of the '393 application. Thus, applicant asserts that the effective filing date of the present application is October 5, 1994. That date is only 16 days after the possible filing date of the '734 patent. Applicant therefore asserts that the provisions of 37 C.F.R. § 1.608(a), and not § 1.608(b), apply. Section 1.608(a) states that “[w]hen the effective filing date of an application is three months or less after the effective filing date of a patent, before an interference will be declared, either the applicant or the applicant’s attorney or agent of record shall file a statement alleging that there is a basis upon which the applicant is entitled to a judgment relative to the patentee.” 37 C.F.R. § 1.608(a).

The undersigned is an agent of record by virtue of the Associate Power of Attorney filed June 15, 2004. The undersigned hereby states that she has a good faith basis for believing that the applicant is entitled to a judgment relative to the '734 patentee.

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<sup>1</sup> The application that issued as the '734 patent indicates that it is a continuation-in-part of an application filed February 27, 1995, which is indicated to be a continuation-in-part of the application filed September 19, 1994. Thus, applicant uses the term “possible” filing date because applicant does not acquiesce to the contention that the claims of the '734 patent are entitled to that filing date.

Applicant respectfully requests withdrawal of the § 102(e) rejection and requests that an interference be declared between the present application and the '734 patent.

Applicant asserts that claim 60 of the present application defines the same patentable invention as claim 1 of the '734 patent. Claim 60 of the present application recites:

60. An isolated DNA that encodes a polypeptide that is at least 80% identical to amino acids 1-134 of SEQ ID NO: 2, wherein the polypeptide encoded by the DNA binds hek/elk.

Claim 1 of the '734 patent recites

1. An isolated nucleic acid encoding a recombinant polypeptide, which polypeptide comprises an Elf-1 polypeptide sequence at least 70 percent identical to an amino acid sequence selected from the group consisting of SEQ ID Nos. 2 and 4, and portions thereof, and which Elf-1 polypeptide specifically binds to an EPH-type receptor.

Claim 1 recites three elements: an isolated nucleic acid, an identity element, and a binding element. Applicant will address the elements in turn.

First, claim 60 of the present application recites "[a]n isolated DNA," which is "[a]n isolated nucleic acid" according to claim 1 of the '734 patent. Second, amino acids 1 to 134 of SEQ ID NO: 2 according to claim 60 of the present application are identical to amino acids 26 to 159 of SEQ ID NO: 2 according to claim 1 of the '734 patent. Thus, "a polypeptide that is at least 80% identical to amino acids 1 to 134 of SEQ ID NO: 2" according to claim 60 of the present application is a polypeptide sequence that is "at least 70% identical to an amino acid sequence . . . of SEQ ID NO: 2 . . . , and portions thereof," according to claim 1 of the '734 patent. Third, with respect to the binding element of the claims, claim 1 of the '734 patent recites that the polypeptide encoded by the isolated nucleic acid "specifically binds to an EPH-type receptor." Claim 60 of the present application recites that "the polypeptide encoded by the DNA binds

hek/elk.” Both hek and elk are members of the EPH family of receptors. See, e.g., specification at page 1, lines 22 to 24; and page 2, lines 4 to 5 and 12 to 18.

For at least the reasons discussed above, applicant asserts that claim 60 of the present application defines the same patentable invention as claim 1 of the '734 patent and respectfully requests that the Examiner declare an interference.

In accordance with 37 C.F.R. § 1.607, applicant proposes the following count, which corresponds to applicant's claim 60 and claim 1 of the '734 patent:

Count 1. (i) An isolated DNA that encodes a polypeptide that is at least 80% identical to amino acids 1-134 of SEQ ID NO: 2, wherein the polypeptide encoded by the DNA binds hek/elk; or

(ii) an isolated nucleic acid encoding a recombinant polypeptide, which polypeptide comprises an Elf-1 polypeptide sequence at least 70 percent identical to an amino acid sequence selected from the group consisting of SEQ ID Nos. 2 and 4, and portions thereof, and which Elf-1 polypeptide specifically binds to an EPH-type receptor.

Applicant asserts that claims 1 to 26 of the '734 patent correspond to the proposed count. Claim 1 of the '734 patent is the same as option (ii) of the proposed count. Claims 2 to 26 of the '734 patent do not recite any independently patentable elements beyond those that are recited in claim 1. Thus, claims 2 to 26 also correspond to option (ii) of the proposed count.

Claims 29 to 52 and 58 to 61 of the present application correspond to the proposed count. Claim 60 is the same as option (i) of the proposed count. Claims 29 to 52 and 58 to 61 rely on the same elements as recited in claim 60 for patentability, although one or more of them may be narrower than claim 60. In other words, claims 29 to 52 and 58 to 61 do not recite any independently patentable elements beyond those that are recited in claim 60.

Rejection under 35 U.S.C. § 135(b)

The Examiner rejected claims 30, 31, 33, 34, 36, 37, 39, 40, 42, 43, 45, 46, 48, 49, 51, 52, and 58-61 under 35 U.S.C. § 135(b) as allegedly “not being made prior to one year from the date on which U.S. Patent No. 5,795,734 was granted.” Action at page 4. The Examiner alleged that those claims were first presented in applicant’s Amendment filed June 30, 2000. *Id.*

Applicant respectfully traverses. The Manual of Patent Examining Procedure (MPEP) states that “. . . under the provisions of 35 U.S.C. 135(b), an interference will not be declared unless at least one of the claims which were in the application, or in a parent application, prior to expiration of the one-year period was for ‘substantially the same subject matter’ as at least one of the claims of the patent.” MPEP § 2307. A claim is considered to be “substantially the same subject matter” as a patent claim if it contains all the material limitations of the patent claim. *Id.*

Applicant asserts that at least one claim that was pending in the present application prior to the expiration of one year from the issue date of the ‘734 patent, i.e., prior to August 18, 1999, was for substantially the same subject matter as at least one of the claims of the patent. For example, claim 2 of the present application recited:

2. An isolated DNA sequence encoding a LERK-6 polypeptide that binds hek/elk and that is at least 90% identical with the sequence of amino acid residues selected from the group consisting of 1 to 184 of SEQ ID NO: 2 and 1 to 104 of SEQ ID NO: 8.

Claim 2 was pending in the application in that form until it was amended in an Amendment filed September 28, 1999, to include conditions for calculating percent identity. Applicant asserts that claim 2 of the present application was for substantially the same subject matter as claim 1 of the ‘734 patent.

As discussed above, claim 1 of the '734 patent recites three elements: an isolated nucleic acid, an identity element, and a binding element. First, claim 2 recited "[a]n isolated DNA sequence," which is "[a]n isolated nucleic acid" according to claim 1 of the '734 patent. Second, amino acids 1 to 184 of SEQ ID NO: 2 according to claim 2 of the present application are identical to amino acids 26 to 209 of SEQ ID NO: 2 according to claim 1 of the '734 patent. Thus, a polypeptide "that is at least 90% identical with the sequence of amino acid residues . . . 1 to 184 of SEQ ID NO: 2" is a polypeptide sequence that is "at least 70% identical to an amino acid sequence . . . of SEQ ID NO: 2 . . . , and portions thereof," according to claim 1 of the '734 patent. Third, as discussed above, "a polypeptide that binds hek/elk" according to claim 2 of the present application is a polypeptide that "specifically binds to an EPH-type receptor" according to claim 1 of the '734 patent.

Thus, for at least those reasons, applicant asserts that, prior to the expiration of one year from the issue date of the '734 patent, the present application included at least one claim that was for substantially the same subject matter as at least one of the claims of the '734 patent. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 135(b).

#### Examiner's Conclusion

The Examiner stated that "[c]laims 53-57 would be allowable." Action at page 5. Claims 53 to 57 were not included in either of the rejections set forth in the Office Action. Thus, since claims 53 to 57 are presently allowable over the '734 patent, those

claims should not be designated as corresponding to the proposed count of the requested interference.


Applicant respectfully asserts that the present application is allowable and requests that the Examiner declare an interference between the application and the '734 patent. If the Examiner does not believe that an interference can be declared at this time, the undersigned requests that, prior to taking action, the Examiner call her at (650) 849-6656 to set up an interview.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 13, 2004

By:   
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